

REMARKS:

Reconsideration and allowance of the claims in the application are requested.

Claims 1-4, 6, 8, 10-11, 13, 15, 17, 19-21, 24, 26, 28-29, 31, 33, 35, 37-39, 41-42 are in the application.

Claims 5, 7, 9, 12, 16, 18, 22, 23, 25, 27, 30, 32, 34, 36, 40 and 43-56 have been withdrawn from consideration.

Claims 1-4, 6, 8, 10-11, 13, 15, 17, 19-21, 24, 26, 28-29, 31, 33, 35, 37-39, 41-42 have been rejected.

Claims 1-4, 8, 11, 13, 17, 19-20, 26, 29, 31, 25, 37-38 and 41-42 have been rejected under 35 USC 103(a) as being unpatentable over USP 6,385,591 B1 to Mankoff, issued May 7, 2002, filed May 11, 1999 (Mankoff) in view of US Publication No. 2002/0007306, published January 17, 2002, filed August 13, 1999 (Granger) and in further view of USP 5,665,953 to Mazzamuto et al., issued September 9, 1997, filed February 14, 1996 (Mazzamuto).

Claims 6, 10, 15, 21, 24, 28, 33 and 39 have been rejected under 35 USC 103(a) as being unpatentable over USP 6,385,591 to Mankoff, issued May 7, 2002, filed May 11, 1999 (Mankoff), in view of US Publication No. 2002/0007306 to Granger et al., published January 17, 2002, filed August 13, 1999 (Granger) and further in view of USP 6,327,300 to Souissi et al., issued December 4, 2001, filed October 25, 1999, (Souissi).

Applicants have amended claims 1, 2, 3, 4, 8, 41 and 42 to further distinguish the present invention from the prior art. Claims 59 and 60 have been added for additional protection.

Before responding to the rejections, Applicants would like to distinguish the cited art, alone or in combination, from the present invention (Rissanen), as follows:

1. Mankoff

Mankoff discloses a personal data assistant (PDA) downloading a coupon and storing the coupon in the PDA. When the user desires to redeem the coupon, the PDA is taken to a terminal located at a retail establishment. The PDA is synchronized to the terminal and the stored coupon is redeemed in an exchange for a discount on a given product or service. Mankoff fails to disclose or suggest limitations of Rissanen, as follows:

- (i) Mankoff discloses downloading a coupon from a website and fails to disclose a website “pushing” coupons to the PDA or terminal.
- (ii) Mankoff discloses the PDA transmitting the stored coupon to a terminal for matching and fails to disclose a PDA or terminal performing a match stored coupon information with wireless transmissions of promotions in effect at a retail outlet.
- (iii) Mankoff discloses a portable terminal storing an image of a coupon and fails to disclose storing a coupon ID in place of an image in a portable terminal.
- (iv) Mankoff discloses a PDA interacting with a point-of-sale terminal and fails to disclose a portable terminal interacting with other portable terminals for transferring coupon purposes.

2. Granger

Granger discloses an in vehicle promotion receiver system receiving transmitted promotion information from a retail outlet when within the transmitter area of the outlet. Granger fails to disclose limitations of Rissanen, as follows:

- (i) Granger discloses an in vehicle systems for receiving promotions when within the range of a transmitter serving a retail outlet and fails to disclose promotions transmitted over a network for storage in a mobile unit regardless of the unit’s location in the network. Modifying Mankoff with Granger would limit the scope of Mankoff to limited locations contrary to the Mankoff promotion system.

3. Mazzamuto discloses a scanner which allows a user to scan product code information from coupons into a memory device; compare scanned product codes with entries in a stored product code list in the scanner and download matched codes after physical engagement with a register at a product purchase location. Mazzamuto fails to disclose limitations of Rissanen, as follows

- (i) Mazzamuto discloses the scanner downloading matched product codes after physical engagement with a register at a product purchase location, and fails to disclose wirelessly transmitting matched product codes to a terminal at a product purchase location for

processing. Modifying Mankoff to include the matching process of Mazzamuto would be contrary to wireless redemption process of Mankoff.

4. Souissi discloses Bluetooth radio technology as a transmission source in a communication system capable of dynamically allocating spectrum for transmitting data. Souissi fails to disclose limitations of Rissanen, as follows:

(i) Souissi discloses determining a desired portion or an available portion of transmission spectrum for data transmission and fails to disclose or suggest Bluetooth protocols for a mobile coupon push delivery and transaction system involving a mobile phone and a point-of-sale terminal.

Summarizing, Mankoff, Granger, Mazzamuto and Souissi, alone or in combination, fail to disclose or suggest or teach (a) a mobile phone implementing a coupon delivery and transaction system; (b) wirelessly transferring coupon or coupon ID information over a network to a mobile phone; (c) storing the coupon or ID information in the mobile phone or at a server for subsequent download; (d) optionally transferring the coupon to another mobile phone on the network (e) initiating in the phone a coupon matching sequence, which matches stored coupon information with wireless transmission of promotions in effect at a point-of-sale terminal; (f) wirelessly transferring the matched coupon information from the mobile phone to the point-of-sale, for redemption during a transaction; and (f) validating at the a point-of-sale terminal the transferred coupon information if the coupon information corresponds to any of the goods or services involved in the transaction.

Now turning to the rejections, Applicants respond to the indicated paragraphs of the Office Action, as follows:

Regarding Paragraph 1:

The Examiner's comments are noted. Applicants select option 1.

Regarding Paragraph 2:

The Examiner's comments are noted.

Regarding Paragraph 3:

Claims 1-4, 8, 11, 13, 17, 19-20, 26, 29, 31, 35, 37-38 and 41-42 include limitations not disclosed or suggested in Mankoff, of record, in view of Granger, of record and in further view of Mazzamuto, of record, as follows:

1. Claim 1:

- (i) “wirelessly transferring by pushing coupon information including a coupon identification (ID) number to a first portable terminal via a network regardless of the terminal’s location in the network”

The Examiner acknowledges that Mankoff fails to disclose “wirelessly pushing coupon information” to a portable terminal and modifies Mankoff to include the teaching of Granger in pushing information to a terminal, as obvious to one of ordinary skill in the art.

Granger, at paragraph 8, discloses an in-vehicle promotion system wherein a person can receive promotion information in their vehicle automatically. Granger, at paragraph 22, discloses promotion information is sent to a RF receiver in the in-vehicle system when the vehicle is within the range of the RF transmitter of a host system. In contrast, Rissanen, at page 3, line 16 discloses electron coupons may be pushed to a terminal by methods including: delivery from a network, e.g. the Internet. Mankoff in view of Granger fails to disclose pushing coupon information over a network regardless of the terminal location in the network..

- (ii) “said pushing being performed without requiring action by the first portable terminal;”

Mankoff fails to disclose wirelessly pushing coupon information to a mobile phone without requiring action by a first portable terminal. Granger at Paragraphs 050-053 requires an in-vehicle system to be (1) within the range of a GPS or Loran receiver , and (2) within the defined transmitting range of a promotion transmitter. i In contrast, Rissanen, at page 7, line 7-9, disclose the coupon is electronically delivered to a wireless terminal regardless of location of the terminal in the network.. Mankoff in view of Granger fail to disclose pushing coupon information to portable terminal without requiring action by the mobile terminal.

(iii) "initiate a coupon matching sequence in the first portable terminal that compares the stored coupon information with wireless transmission for promotions in effect at a retail outlet"

The Examiner acknowledges that Mankoff fails to disclose "a coupon matching that compares the stored coupon of promotions.." and modifies Mankoff to include the teaching of Mazzamuto in matching scanned information in a scanner with stored information in the scanner, as obvious to one of ordinary skill in the art.

Mazzumotto at col. 2, lines 39-54 discloses a scanner capable of reading product code information from a coupon; comparing a scanned product code information with the product coupon lists stored in a first memory in the scanner to find a match; assigning an unique identifier to the match product code information, and storing a lists of matched product code information and corresponding unique identifiers as individual entries in a second memory device in the scanner; wherein, the item entries can be retrieved and tallied by a register at a product purchase location. In contrast, Rissanen, at page 4, lines 1-24, discloses coupon files are stored in a memory of a mobile terminal or downloaded separately from a network server, as needed. During a visit to a retail outlet, the consumer takes out his/her mobile terminal, initiates a coupon match sequence that compares the coupon files stored in the terminal with promotions effective at the retail outlet. If a match is found, the point-of-sale terminal calculates a discount to the price of goods to be purchased. Rissanen performs a matching sequence in the mobile terminal between coupons stored in the terminal and promotions effective at the retail outlet, the mobile terminal and the point-of-sale terminal exchanging electronic coupon information to complete a transaction. Mazzamuto compares scanned product code information with a product code list stored in the scanner. Rissanen compares stored information with transmitted information from a point-of-sale terminal.

(iv) "wirelessly transferring at least part of the stored coupon information ... the coupon ID number from the first portable terminal to another terminal for redemption during the transaction;"

Mankoff, at col. 5, lines 37-38, discloses a fraud prevention technique is to associate a given identifier (e.g., a coupon serial number) with a given user. In contrast, Rissanen, at page

16, lines 20-25, discloses once a coupon ID has been stored by a wireless terminal, the coupon image may be downloaded from a coupon service server; thereby, eliminating inefficient conventional steps used in redeeming paper coupons. Mankoff fails to disclose transmitting coupon ID's in lieu of the coupon image, thereby, saving storage, bandwidth, and processing time.

(v) "validating in the another terminal the transferred coupon information"

Mankoff, at col. 5, lines 40-46, discloses validating the coupon by sending a message to a server that issued the coupon or that manages validity checks. In contrast, Rissanen, at page 8, lines 12-16, discloses the point-of-sale terminal validates the electronically transmitted coupon and electronically redeems it. Mankoff fails to disclose the point-of-sale terminal validating and redeeming the coupon.

Summarizing, Mankoff, in view of Granger and Mazzamuto discloses a coupon delivery and redemption sequence between a portable terminal and a transaction terminal in which (a) coupons are delivered to the portable terminal when within the range of the transaction terminal; (b) scanned coupons are matched with stored information in the portable terminal; and (c) the portable terminal transfers the coupon to the transaction terminal for redemption when matching occurs. Mankoff, in view of Granger and Mazzamuto, fails to disclose an electronic couponing system and method, which (a) pushes coupons to a portable terminal regardless of location in a network and without requiring user action, (b) stores coupon information and/or associated ID information in the portable terminal; (c) matches stored coupon information or ID information to promotions' information wirelessly transferred by a point-of-sale terminal; and (d) electronically transfers the matched coupons and promotion information to the point-of-sale terminal for validation and redemption.

Moreover, the combination of Mankoff and Granger or Mazzamuto would be inoperative by Granger requiring the portable terminal to be within a defined range of a transaction terminal and Mazzamuto matching scanned coupons to information stored in the portable terminal and not to promotions wirelessly transferred to the portable terminal by the transaction terminal. A worker skilled in the art would no basis in the cited art to implement claim 1.

The rejection of claim 1 under 35 USC 103(a) is not supported by cited art. Withdrawal of the rejection and allowance of claim 1 are requested.

2. Claim 2:

- (i) "wirelessly transferring at least part of the stored coupon information corresponding to granted discounts ... to a second portable terminal to affect wider distribution of the coupon information so as to permit users of each of said first and second portable terminals to redeem said coupon information during different transaction."

Mankoff discloses a consumer clips coupons on the web and organize them in an PDA for other portable computing devices. Column 4, lines 37-40.

Granger discloses a portable terminal when within the range of a retail outlet receives promotions, which may be printed data in a vehicle for use in the retail outlet. Paragraph 22 and 24.

Mazzamuto discloses a portable scanner scanning product code information from a coupon; comparing the scanned product information with a product coupon list stored in a scanner to find a match, wherein, the stored entries can be retrieved and tallied by a register at a product purchase location. Abstract.

Applicant can find no disclosure in Mankoff, Granger or Mazzamuto, nor has the Examiner identified any disclosure in the cited art, relating to transferring coupons from one mobile device to another device to enable each mobile devices to redeem the same coupon information in different transaction at the same terminal or at different transaction terminals. Page 7, lines 19-27.

Summarizing, the cited art fails to disclose or suggest (1) the limitations of claim 1 in claim 2 for the reasons indicated in connection with the consideration of claim 1, and (2) the absence of disclosure in the cited references transferring coupons from one portable device to another portable device to conduct separate transactions on the same coupon information.

A worker skilled in the art has no basis in the cited art for implementing claim 2.

The rejection of claim 2 is without support in the cited art. Withdrawal of the rejection and allowance of claim 2 are requested.

3. Claim 3:

- (i) “said first portable terminal storing in the coupon (ID) number in said memory, a visual representation of the coupon information being stored in a remote server for subsequent downloading to another terminal,”

Mankoff discloses an electronic or “virtual coupon is obtained when a user selects a given link in a Web page being displayed on a client machine . . . the virtual coupon is then saved to a file on a client machine.” Abstract.

Granger discloses when a vehicle is driven within a certain proximity of a store, the promotion information, which may include coupons is automatically displayed on the in vehicle system. Abstract.

Mazzamuto discloses comparing scanned product code information with a product coupon list stored in a first memory device to find a match and displaying the match product code information on a display wherein the item entries can be retrieved and tallied by a register at a product purchase location. Abstract.

In contrast, Rissanen, at page 4, lines 4-7, discloses a coupon ID member is stored in the mobile terminal and a visual representation stored in a server for downloaded separately from a network server, as needed or when excess bandwidth requirements exist.

Mankoff, Granger and Mazzamuto all fail to disclose storing coupon ID information in the mobile terminal and a visual representation of the coupon information in a remote server for subsequent downloading when needed at the time of redeeming the coupon.

Claim 3 includes the limitations of claim 1, and without a disclosure in the cited references, alone or in combination, relating to storing a visual representation of coupon information in a remote server for subsequent downloading; matching and redemption purposes coupon information, there is no basis for a worker skilled in the art to implement claim 3. The rejection of claim 3 under 35 USC 103(a) is without support in the cited art. Withdrawal of the rejection and allowance of claim 3 are requested.

4. Claim 4:

Claim 4 includes the limitations of claim 1 and 3 and is patentable on the same basis thereof.

Summarizing, claims 1-4 include limitations relating to (a) pushing coupon information to a portable terminal, via a network, regardless of the terminal location in the network; (b) storing coupon ID information in a portable terminal, a visual representation of the coupon ID information being stored in the remote server for subsequent downloading to the portable terminal when needed; (c) matching coupon information to promotion information wirelessly provided by another terminal for subsequent transfer of the coupon information to the another terminal for validation and redemption purposes, when matching occurs, and (d) transfer of a coupon or coupon ID from one portable terminal to another portable terminal for wider distribution and redemption of the coupon in different transaction at the same or different terminals. Mankoff, Granger and Mazzamuto, alone or in combination, all fail to disclose or suggest the limitations (a), (b), (c) and (d), above and without such disclosure there is no basis for a worker skilled in the art to implement claims 1-4. The rejection of claims 1 - 4 is without support in the cited art. Withdrawal of the rejection and allowance of claims 1 - 4 are requested.

5. Claim 7-8:

Claim 7 was cancelled in the Amendment filed July 1, 2004. Claim 8 has been amended to depend upon claim 1.

Claim 8 further limits claim 1 and is patentable on the same basis thereof.

6. Claims 11, 17, 29 & 38:

Claim 11 further limits claim 1 and is patentable on the same basis thereof.

Claim 17 further limits claim 2 and is patentable on the same basis thereof.

Claim 29, further limits claim 3 and is patentable on the same basis thereof.

Claim 38 further limits claim 4 and is patentable on the same basis thereof.

7. Claim 18-20:

Claim 18 was canceled in an Amendment filed July 1, 2004.

Claim 19 further limits claim 2 and is patentable on the same basis thereof.

Claim 20 further limits claim 2 and is patentable on the same basis thereof.

8. Claims 6, 10, 15, 21, 24, 28, 33 & 39:

Claims 6, 10, 15, 21, 24, 28, 33 & 39 include limitations not disclosed or suggested in Mankoff, of record, in view of Granger, of record, in view of Mazzamuto, of record and further in view of Souissi, of record.

Claims 6 and 10 further limit claim one and are patentable on the same basis thereof.

Claim 15 further limits claim 2 and is patentable on the same basis thereof.

Claim 21 further limits claim 2 and is patentable on the same basis thereof.

Claim 24, further limits claim 3 and is patentable on the same basis thereof.

Claim 28 further limits claim 3 and is patentable on the same basis thereof.

Claim 33 further limits claim 4 and is patentable on the same basis thereof.

Claim 29 further limits claim 4 and is patentable on the same basis thereof.

9. Claim 41:

Claim 41 has been amended to include the limitations of claims 1, 2 and 3. In particular, claim 41 has been amended to describe the wireless distribution of coupons to first, second and other portable terminals to permit users to redeem coupon information during different transactions, as described in the specification at page 15, lines 4-6.

In any case, claim 41 further limits claims 1, 2 and 3 and is patentable on the same basis thereof.

10. Claim 42:

- (i) "a mobile phone having a memory and a scanner for scanning coupon information including a coupon identification (ID) number;"

The specification at page 16, lines 1-11, describes a mobile phone including a scanner for scanning coupons and storing coupon information in a memory for subsequent wireless transfer to other mobile phones.

Mankoff at col. 3, lines 16-19, discloses a handheld computing device, such as a personal digital assistance, including a handheld system for imprinting information into the device. Mankoff fails to disclose a handheld device including a scanner for inputting information into the device.

Granger, at paragraph 42, discloses an in-vehicle display system installed in a vehicle. Granger fails to disclose a mobile phone including a scanner for inputting coupon information into a memory.

Mazzamuto, at col. 3, lines 12-29, discloses a data collector including a scanner for scanning machine product code information from a coupon and storing the scanned information in a memory for transfer of the matched information to a terminal after physical engagement with the terminal. Mazzamuto fails to disclose a mobile phone including a scanner implementing a wireless coupon delivery system by wirelessly transferring matched coupon information to a point of sale terminal for validation and redemption.

None of the cited art discloses a mobile phone including a scanner for inputting coupon information into a memory and matching the stored coupon information to promotions wirelessly transferred by a point of sale terminal. Thereafter, wirelessly transferring the matched coupon information to the point of sale terminal for validation and redemption, after physically engaging the terminals

Claim 42 describes subject matter not disclosed in Mankoff, Granger and Mazzumuto, alone or in combination, and is patentable over the cited art. Withdrawal of the rejection and allowance of claim 4 are requested. In any case, claim 42 includes the limitation of claim 3 and is patentable on the same basis thereof.

PATENTABILITY SUPPORT FOR NEW CLAIMS 59& 60:

New Claim 59 describes the mobile terminal storing and sharing coupon information with other mobile terminals; wirelessly receiving promotions from a service terminal; matching the promotions to coupons stored in the terminal; wirelessly transmitting matched coupon information to the service terminal, and receiving a discount after validation of the transferred coupon information in the terminal. The cited prior art fails to disclose or suggest the limitations of New Claim 59 for the reasons discussed in the response to Paragraph 4 of the Office Action.

New Claim 60 describes a service terminal wirelessly transferring promotions to a mobile terminal sharing coupon information with at least one other mobile terminal; the terminal wirelessly receiving requests for discounts from mobile terminals sharing coupon information; validating requests and granting discounts to the requesting mobile terminals sharing coupon information. The cited art fails to disclose or suggest the limitations of New Claim 60 for the reasons discussed in the response to Paragraph 4 of the Office Action, particularly claim 2.

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Response to November 22, 2004 Office Action

Attorney Docket: 4208-4198

CONCLUSION:

Having amended claims 1, 2, 3, 4, 41 and 42 to further distinguish the present invention from the cited art and supported the patentability of New Claims 59 and 60, Applicants request entry of the amendment, allowance of the claims and passage to issue of the case.

AUTHORIZATION:

The Commissioner is hereby authorized to charge any additional fees which may be required for consideration of this Amendment to Deposit Account No. 13-4503, Order No. 4208-4198. A DUPLICATE OF THIS DOCUMENT IS ATTACHED.

In the event that an extension of time is required, or which may be required in addition to that requested in a petition for an extension of time, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to Deposit Account No. 13-4503, Order No. 4208-4198. A DUPLICATE OF THIS DOCUMENT IS ATTACHED.

Respectfully submitted,

MORGAN & FINNEGAN, O.K.

Dated: February 8, 2005

By: _____

Joseph C. Redmond, Jr.

Reg. No. 18,753

Telephone: (202) 857-7887

Facsimile: (202) 857-7929

Brian W. Brown
Reg. No. 47,265

CORRESPONDENCE ADDRESS:

Morgan & Finnegan LLP.
3 World Financial Center
New York, NY 10281-2101